



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SV

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/378,233	08/19/99	PALMER	W 2068.001

021917
MCHALE & SLAVIN
4440 PGA BLVD
SUITE 402
PALM BEACH GARDENS FL 33410

IM52/1023

EXAMINER

BHAT, N

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 10/23/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/378,233

Applicant(s)

PALMER ET AL.

Examiner

N. Bhat

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6, 8, 10-12, 14-16, 18, 19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 8, 10-12, 14-16, 18-19, and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1761

DETAILED ACTION

1. Applicant's amendments and arguments have been fully and carefully considered. Applicant's amendment has entered new matter, which will be detailed below. Applicant's arguments regarding claims 18-19 and 28 are persuasive.

Applicant's amendments to the claims obviate all objections and previous 112, 2nd rejections made in the last office actions and are accordingly withdrawn.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-4,6,8,10-12,14-16,18-19,21-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has introduced by way of amendment the term "sensory effect" which has no direct antecedence in the specification. The original claims recited an effect, which could be either an audible or visible effect when the food is consumed. The effect could also be a physical effect if the food were to vibrate etc. The term sensory effect is broader in scope than visible, audible or physical applicant is entitled to these three types of effects and combinations thereof. Suitable correction is required.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1761

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-4, 6, 8, 10-12, 14-16, and 21-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Filo et al.

Filo et al. Teach a device and method transmitting sound waves between a signal source and a user's ears wherein the sound can by pass the air which comprises an edible substance and signal source operatively associated with the edible substance and configured to produce sound waves for transmission through the edible substance to a user's mouth from which the are conducted by the teeth and bones to the user's ears as sound. The signal source alternatively may produce sound waves using a microphone or transducer device. The device of Filo et al. includes a grasping holder (14), which is held by a hand and can be manipulated which actuates the signal source using switch (20) and placing the edible substance in contact with the mouth of the user. The signal source or transducer is connected to the holding device. Sound waves travel through the edible substance to the user's mouth. [Note the abstract and column 2, lines 36-68 and column 3, lines 49-66]. The device of Filo et al. provides a holding device which includes a rigid housing assembly having means for holding food, the food, and means for producing at least one effect, the effect being sound and further includes a power supply for energizing the output means which alters the physical interaction between the foodstuff member and the manipulator wherein the person consuming the

Art Unit: 1761

food items is the manipulator and manipulates the food which causes a corresponding change in sensory effect (i.e. audible, physical (vibration), or visual (change in color)).

However, Filo et al. does not specifically recite the effect of electrical stimulation is effective in altering the taste of the food.

It is maintained that it would have been obvious to one having ordinary skill in the art to provide a combination foodstuff-holding device that produces an effect such as sound or light, which will interact with the food, which produces different effects based upon manipulation by the manipulator, i.e., the person consuming the food. Filo et al. teach that the combination can comprise a connection between the edible substance and the signal source whereby signals from the signal source may be transmitted to the edible substance. The device can be configured to receive variable, radio signals, and may original from commercial AM/FM radio stations or my be from dedicated transmitters. Although not specifically recited, the fact that the radio waves changes the taste of the food would be subject to the user and since applicant is also using radio waves and sound waves as described by Filo et al. it would have been obvious to one having ordinary skill in the art at the time the invention was made to reasonably expect that the electrical stimulation may be effective in altering the taste of the food.

6. Claims 18-19 and 28 are free of the prior art.

7. With respect to taste, applicant is cautioned that taste is a subjective and in the food art, patentability does not generally rest on "taste" because the PTO does not have any testing facilities and there is really no way an examiner can make a determination that the electrical stimulation would in fact alter the taste of food.

Art Unit: 1761

8. Regarding applicant's arguments that Filo et al. teaches only the sensory effect of aural sound or physically transmitted sound, this argument is persuasive and claims 18-19 have been indicated as being allowable. Claim 28 is allowable as Filo et al. does not teach the concept of an open circuit and when the food is consumed the circuit is closed. With respect to applicant's argument that the claims and specifically claim 21 require a change in the sensor effect proportionate to the inter-relationship with the manipulator and that there is no suggestion in Filo et al. that device is capable of a variable function is not persuasive and because Filo et al. teaches a when the edible source is held by the person or the "manipulator", and consumed or licked or brought into contact with a person's teeth, a sensory effect will occur there is interrelationship between the person eating or consuming the edible food who is holding the combination device and food holder of Filo et al.

9. Applicant is suggested to have an interview on this case in order to expedite prosecution and clear up at least the new matter problems. Perhaps after applicant has the opportunity to review this action and get a better understanding of the examiner's interpretation of Filo et al; the examiner and applicant's representative can together draft a claim which define over Filo et al.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1761

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat
Primary Examiner
Art Unit 1761